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TO: U. S. Patent and Trademark Office
Technology Center 1700
Attn: Examiner, Jonas N. Strickland
Art Unit: 1754

FAX NO.: (703) 872-9311

DATE: November 21, 2003

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CLIENT NO.: 1856-08101

TOTAL NUMBER OF PAGES (INCLUDING THIS ONE) 26

COMMENTS: Re: U.S. Patent Application No. 09/838,070
Filing Date: April 19, 2001
Applicant: Hasan Dindi et al.

The following documents are attached for filing:

- Transmittal Form (PTO/SB/021) (1 p.)
- Request for Removal of Finality (3 p.)
- Response to Office Action of September 25, 2003 (9 p.)
- Attachment to Response to Office Action of September 25, 2003 (12 p.)

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114544.01/1856.08101

PTO/SB/21 (05-03)

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TRANSMITTAL FORM <i>(to be used for all correspondence after initial filing)</i>	Application Number	09/838,070
	Filing Date	April 19, 2001
	First Named Inventor	Hasan Dindi et al.
	Art Unit	1754
	Examiner Name	Jonas N. Strickland
Total Number of Pages in This Submission	Attorney Docket Number	1856-08101

ENCLOSURES (check all that apply)		
<input type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input checked="" type="checkbox"/> Amendment/Reply <input checked="" type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts/ Incomplete Application <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s)	<input type="checkbox"/> After Allowance Communication to Group <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to Group <i>(Appeal Notice, Brief, Reply Brief)</i> <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): <ul style="list-style-type: none"> • Fax Coversheet • Request for Removal of Finality of Office Action dated September 25, 2003 • Attachment to Response to Office Action dated September 25, 2003
<div style="border: 1px solid black; width: 100px; float: left; margin-right: 10px;">Remarks</div>		

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT	
Firm Or Individual Name	Carol G. Mintz, Reg. No. 38,561
Signature	<i>Carol G. Mintz</i>
Date	November 21, 2003

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No. : 09/838,070
Applicants : Hasan Dindi, *et al.*
Filed : April 19, 2001
For : Rhodium Foam Catalyst for the Partial Oxidation of Hydrocarbons
TC/A.U. : 1754
Examiner : Jonas N. Strickland

Confirmation No. 9565

OFFICIAL

Customer No.: 31889
Atty. Dkt. No.: 1856-08101
Date: November 21, 2003

Commissioner for Patents
P.O. Box 1450
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**REQUEST FOR REMOVAL OF FINALITY
OF OFFICE ACTION DATED SEPTEMBER 25, 2003**

Sir:

This request is submitted together with the enclosed *Response to Office Action of September 25, 2003*. In the Office Action all claims are finally rejected in view of a newly cited reference, U.S. Patent No. 5,510,056 (Jacobs et al.). It is said that Applicants' amendment of the claims necessitated the new ground of rejection. It should be noted, however, that the Jacobs et al. reference was submitted by Applicants in an Information Disclosure Statement on September 13, 2001. The Office Action of May 7, 2003 indicated that the Jacobs et al. reference had been considered by the Examiner.

Applicants respectfully traverse the finality of the Office Action for at least the reason that there are claims in this application which have not been amended in such a way that a final rejection over a new reference is justified. The MPEP §706.07(a) states,

...[A] second or any subsequent action on the merits in any application ... will not be made final if it includes a rejection, on newly cited art, ... of any claim not amended by applicant ... in spite of the fact that other claims may have been amended to require newly cited art.

and

A second or any subsequent action on the merits in any application ... should not be made final if it includes a rejection, on prior art not of record, of any claim amended to include limitations which should reasonably have been expected to be claimed.

In the instant matter, claim 3 was rewritten in independent form incorporating the limitations of claims 1 and 2, which were canceled. Likewise, claim 17 was rewritten in independent form incorporating the limitations of canceled claims 15 and 16. In a similar manner, claim 30 was rewritten in independent form incorporating most of the limitations of canceled claims 28 and 29. Additionally, the temperature range "50°C - 700°C" was incorporated from claim 22 into claim 30. Claims 4-14, 18-27, 31-34 and 38 were amended only to change their dependency from a canceled claim to the appropriate re-written claim 3, 17 or 30. Each of these amendments should reasonably have been expected to include limitations from other claims and/or to change the dependency from canceled claims.

Although new claims 39-43 might arguably have necessitated the application of a new reference, it does not appear that any particular teaching of the new reference is actually cited against the limitations of claims 41-43. For example, on page 5 of the Detailed Action it is stated,

With respect to claims 41-43, it would have been obvious to one of ordinary skill in the art to achieve the desired catalyst activity times and disks, since Mercera et al. in view of Hershkowitz et al. and Jacobs et al. are directed towards partial oxidation processes, using rhodium on foam substrates.

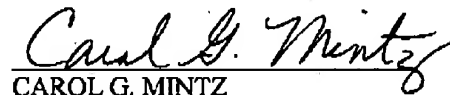
Applicants respectfully submit that it is not proper to apply the new reference to claims 3-14, 17-27, 30-34 and 37-38 for the first time in a final Office Action. For example, claim 3 was merely rewritten in independent form incorporating the limitations of now-canceled claim 1 and intervening claim 2, without substantially changing the original scope of the claim. It is unfair to the Applicants to now raise for the first time a new reference against claim 3, without a valid reason for doing so, and to make that new rejection final. No further search was necessitated by the claim amendments. As mentioned above, the Jacobs et al. reference had already been considered, as evidenced by the initialed copy of the Information Disclosure Statement attached to the first Office Action dated May 7, 2003.

As another example, claim 37 is merely rewritten in independent form incorporating the limitations of now-canceled claims 35 and 36, and making minor adjustments to the wording to improve claim form. The scope of claim 37 is essentially unchanged, and yet the new reference is now the sole basis for rejection of claim 37. No specific reason is given in the Office Action for the conclusion that "Applicant's amendment necessitated the new ground(s) of rejection presented in this Office Action." If the finality of the Office Action of September 25, 2003 is maintained,

Applicants' respectfully request clarification of the reason that the amendment necessitated application of the new reference.

Accordingly, Applicants respectfully request withdrawal of the finality of the Office Action of September 25, 2003 and consideration of the concurrently filed Response.

Respectfully submitted,



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